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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/775,019  
Filing Date: February 01, 2001  
Appellant(s): GRIFFITH, DAVID

David W. O'Brien, Reg. No. 40,107  
For Appellant

**SUPPLEMENTAL EXAMINER'S ANSWER**

This is in response to the Appeal Brief and Amendment After Brief filed 21 September 2006 appealing from the Office action mailed 2 March 2006.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The amendments after final rejection filed on 21 September 2006 and 2 May 2006 have been entered.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

Claims 3-15, 19-21, and 24 should have been listed as the claims to be appealed in this section. In addition, while part 1 of the Appellant's statement of the grounds of rejection to be

reviewed on appeal is correct, Examiner notes that Part 2 of the grounds of rejection to be reviewed on appeal would be more appropriately placed in the "arguments" section, as there is only one ground of rejection in this Application.

Moreover, appellant's statement of the grounds of rejection to be reviewed on appeal does not include the following New Grounds of rejection, which has been added, and is set forth both here and in Section (9) of this supplemental examiner's answer.

The following new ground(s) of rejection are applicable to the appealed claims:

***(New Grounds) Claim Rejections - 35 USC § 101***

1. 35 U.S.C. § 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 3-15, 19-21, and 24 are rejected under 35 U.S.C. §101.

A) As per claims 3-15 and 24, these appear to be directed toward a method or process for preparing an executable representation of a rating model. Based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9

(1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

In the instant application, Appellant's method steps fail the first prong of the new Federal Circuit decision since they are not required to be tied to another statutory class and can be performed without the use of a particular apparatus. Furthermore, the method steps fail to unambiguously require transformation of underlying subject matter to a different state or thing. The mere manipulation and production of non-functional descriptive material (i.e., an actuary-manipulable representation of a rating model) is not a transformation because neither an actuary-manipulable representation of a rating model nor an executable representation is statutory subject matter. Thus, claims 3-15, and 24 are non-statutory since they are not requisitely tied to another statutory class and they do not requisitely transform underlying subject matter to a different state or thing.

B) As per claims 19-21, these appear to be directed toward a computer program product *per se*. Computer programs *per se* intrinsically require no tangible physical structure, thus do not constitute tangible physical articles or other forms of matter. Therefore, computer programs *per se* are not considered to be statutory subject matter. To be statutory, a computer program must be: (1) coupled with or combined with some statutory physical structure, and, (2) produce or effect some useful, concrete, and tangible result.

#### **(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

#### **(8) Evidence Relied Upon**

2002/0046064	Maury et al.	04-2002
60/206,007	Maury et al.	05-2000

#### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

#### ***(New Grounds) Claim Rejections - 35 USC § 101***

#### **3. 35 U.S.C. § 101 reads as follows:**

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 3-15, 19-21, and 24 are rejected under 35 U.S.C. §101.

A) As per claims 3-15 and 24, these appear to be directed toward a method or process for preparing an executable representation of a rating model. Based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

In the instant application, Appellant's method steps fail the first prong of the new Federal Circuit decision since they are not required to be tied to another statutory class and can be performed without the use of a particular apparatus. Furthermore, the method steps fail to unambiguously require transformation of underlying subject matter to a different state or thing. The mere manipulation and production of non-functional descriptive material (i.e., an actuary-

manipulable representation of a rating model) is not a transformation because neither an actuary-manipulable representation of a rating model nor an executable representation is statutory subject matter. Thus, claims 3-15, and 24 are non-statutory since they are not requisitely tied to another statutory class and they do not requisitely transform underlying subject matter to a different state or thing.

B) As per claims 19-21, these appear to be directed toward a computer program product *per se*. Computer programs *per se* intrinsically require no tangible physical structure, thus do not constitute tangible physical articles or other forms of matter. Therefore, computer programs *per se* are not considered to be statutory subject matter. To be statutory, a computer program must be: (1) coupled with or combined with some statutory physical structure, and, (2) produce or effect some useful, concrete, and tangible result.

Claims 10-15, 3-9, 19-21 and 24 are rejected under 35 U.S.C. §103(a).

These rejections are set forth in prior Office Action, Paper No 12092005 and reproduced hereinbelow. The rejections which appear below substantially repeat the rejections made in the previous Office Action (Paper No 12092005). The text of those sections of Title 35 U.S. Code relied upon in the Examiner's Answer is set forth in the previous Office action, Paper 12092005.

1. Claims 10-15, 3-9 and 19-21, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maury, U.S. Patent Application Publication Number 2002/0046064.



(A) As per claim 10, Maury teaches a method of preparing an executable representation of a rating model (Examiner interprets “an executable representation of a rating model” to be computer executable code embodied on a computer readable medium, and therefore statutory subject matter), the method comprising:

defining an actuary-manipulable representation of a rating model, the actuary-manipulable representation including variables, factor tables and calculation sequences of the rating model, the calculation sequences defined in terms of steps operative on values of the variables and cells of the factor tables (Maury; paragraphs [0030]-[0033]; and

transforming the actuary-manipulable representation to the executable representation, the executable representation including a runtime lookup facility for identification of runtime identifiers in the executable representation corresponding to ones of the variables and a calculate method executable to generate a quote based on inputs supplied via a predefined input interface (Maury; paragraphs [0034], [0037]-[0039]).

Maury fails to explicitly disclose “factor tables having one or more axes.” However, the above features are well known in the art, and Maury clearly teaches “[t]he DTP can accept multiple sets of data from different data models with the same set of actions performed on each” and “multiple data sets with multiple table blocks in each. The instructions are carried out upon each data set” (Maury; paragraph [0035]).

It is respectfully submitted that since Maury is directed to “providing a user with an on-line, real-time quote for an insurance product” (Maury; paragraph [0003]), the

manipulation of “multiple data sets with multiple table blocks” of Maury, as recited in the above passage, broadly reads on the claimed “factor tables having one or more axes.” It is the position of the Examiner that one having ordinary skill in the art at the time of the invention would have found it obvious to include factor tables having one or more axes within the method disclosed by Maury, with the motivation of furnishing an on-line quote to a user for an insurance product, such as auto insurance, which enables the quote to be presented in real time, without the delay inherent, for example, with the use of email (Maury; paragraph [0005]). Furthermore, as described in Applicant’s specification (page 1, lines 20-23), “[w]hen taken together, the calculation sequence, the variables, and the factor tables (or tables of adjustments) make up a rating model. An insurance company will typically have a rating model for each line of insurance it offers.”

(B) As per claims 11-12, Maury teaches a method as analyzed and discussed in claim 10 above

wherein, for a particular calculation sequence of the actuary-manipulable representation, the transforming includes:

decomposing the particular calculation sequence into layers, each layer including those steps thereof that are at a same flow control level (Maury; paragraphs [0028], [0034]);

for each layer, traversing the steps thereof to identify those of the variables used by the layer (Maury; paragraph [0034], [0041]);

for each layer, traversing the calculation sequence to identify the steps of the layer targeted by other steps of the calculation sequence and emitting code allocating storage for results of the targeted steps (Maury; paragraph [0041]); and

for each layer, emitting code for variable test and index calculations of the layer (Maury; paragraph [0041]); Examiner interprets Maury's teaching of "the underwriter copies its underwriting rules and moves them to live on the server 48 that houses the rating engine 64 for its underwriting" (Maury; paragraph [0041]) to teach a form of traversing the steps or selecting rules to apply; and

wherein the transforming includes:

emitting, for a particular calculation sequence, both logged and non-logged versions of the executable representation (Maury; paragraph [0012]).

(C) As per claims 13-15, Maury teaches a method as analyzed and discussed in claim 10 above

wherein the transforming includes a two-step compilation,

a first step thereof producing a platform independent source form from the actuary-manipulable representation (Maury; paragraphs [0024], [0031]), and

a second step thereof producing the executable representation from the platform independent source form (Maury; paragraphs [0024], [0031]);

wherein the runtime lookup facility of the executable representation includes a predefined interface for obtaining the runtime identifiers corresponding to respective ones of the variables and factor tables of the rating model (Maury; paragraphs [0028]-[0029], [0031], [0034]); and

wherein the runtime identifiers allow client code to set and access runtime storage corresponding to respective ones of the variables and factor tables (Maury; paragraphs [0028]-[0029], [0031], [0034]);

wherein the client code is part of a networked information service (Maury; paragraphs [0024], [0028]-[0029], [0031], [0034]); and

wherein the executable representation of the rating model is employed to prepare a quote for presentation by the networked information service (Maury; paragraphs [0024], [0028]-[0029], [0031], [0034]).

(D) As per claims 24, 3, Maury teaches a method as analyzed and discussed in claim 10 above

further comprising:

executing the executable representation to calculate a quote for an insurance product (Maury; paragraphs [0024]-[0025], [0031]-[0032], [0034]); and

wherein the rating model defining is performed in accordance with XML (reads on “a predefined document type definition”); Examiner interprets Maury’s teaching of “the

system application is written with Cold Fusion, Java, C, C++, Hypertext Markup Language (HTML), and JavaScript” (Maury; paragraph [0024]) as teaching using an assortment of markup languages to enable real-time insurance quoting. It is the position of the Examiner that one having ordinary skill in the art at the time of the invention would have found it obvious to include additional markup languages such as XML (reads on “a predefined document type definition”) within the method disclosed by Maury, with the motivation of using a publicly available, standardized data format (XML) to enable the meaningful exchange of data between the computers hosted by the web server and the resource server in order to further define the language for the intended audience, i.e. “various affinity groups,” in order to provide the individualized service required to achieve Maury’s recited objective of providing “the online quoting facility on affinity client websites” (Maury; paragraphs [0005], [0024], [0027]).

(E) As per claims 4-6, Maury teaches a method as analyzed and discussed in claims 10 and 24 above

wherein the transforming to the executable representation includes compilation of the actuary-manipulable representation to a platform independent executable form such as Java (Maury; paragraphs [0024], [0031]); and

wherein the executable representation includes:

predefined input and output interfaces (Maury; paragraphs [0034], [0037]-[0039];

a runtime lookup facility for identification of runtime identifiers in the executable representation corresponding to ones of the variables (Maury; paragraphs [0034], [0037]-[0039]); and

a calculate method of the compiled rating model executable to generate the quote based on inputs supplied via the input interface (Maury; paragraphs [0034], [0037]-[0039]);

employing the runtime lookup facility to identify particular runtime identifiers corresponding to particular variables (Maury; paragraphs [0028]-[0029], [0031], [0034], [0037]-[0039]);

setting values for the particular variables using the corresponding runtime identifiers and the predefined input interface (Maury; paragraphs [0028]-[0029], [0031], [0034], [0037]-[0039]); and

retrieving the quote via the predefined output interface (Maury; paragraphs [0034], [0037]-[0039]).

(F) As per claims 7-8, Maury teaches a method as analyzed and discussed in claims 10 and 24 above

wherein the actuary-manipulable representation includes markup language encoded metadata (such as those based on markup languages such as XML) (Maury; paragraph [0024]);

wherein the actuary-manipulable representation is XML, encoded (Maury; paragraph [0024]); Examiner interprets Maury's teaching of "the system application is written with Cold Fusion, Java, C, C++, Hypertext Markup Language (HTML), and JavaScript" (Maury; paragraph [0024]) as teaching using an assortment of markup languages to enable real-time insurance quoting. It is the position of the Examiner that one having ordinary skill in the art at the time of the invention would have found it obvious to include additional markup languages such as XML within the method disclosed by Maury, with the motivation of using a publicly available, standardized data format (XML) to enable the meaningful exchange of data between the computers hosted by the web server; and the resource server in order to further define the language for the intended audience, i.e. "various affinity groups," in order to provide the individualized service required to achieve Maury's recited objective of providing "the online quoting facility on affinity client websites" (Maury; paragraphs [0005], [0024], [0027]).

(G) As per claim 9, Maury teaches a method as analyzed and discussed in claims 10 and 24 above

wherein the actuary-manipulable representation includes a graphical user interface presentation of the variables, factor tables and computational flows of the rating model based on markup language encoded metadata (Maury; paragraphs [0024]-[0025]).

(H) Claims 19, 21 differ from method claims 10, 15 by reciting a “computer program product” in the preamble. As per this limitation, Maury’s method is inherently implemented on a computer, as it is directed to “providing a user with an on-line, real-time quote for an insurance product, such as an auto insurance product” (Maury; paragraph [0002]). As such, Maury implicitly includes computer elements such as a computer program product. The remainder of claims 19, 21 repeat the limitations of claim 10, 15, and are therefore rejected for the same reasons given above for claim 10, 15.

(I) As per claim 20, Maury teaches a method as analyzed and discussed in claim 19 above

wherein the runtime identifiers allow client code to employ the compiled rating model without knowledge of internals thereof (Maury; paragraph [0024]; Examiner interprets Maury’s teaching of “[t]he system connects to the rating server 48, such as a proprietary rating engine available from Agency Management System, Inc., prefills data into a host application and stores data to be retrieved via a computer telephony integration (CTI) system” (Maury; paragraph [0024] as teaching this limitation.



**(10) Response to Argument**

In the Appeal Brief filed 21 September 2006, Appellant makes the following argument:

**ARGUMENT**

1. ERROR 1:           Maury does not disclose Appellant's invention and no  
*prima facie* case of obviousness exists.
2. ERROR 2           The Maury provisional application does not contain the  
limitations of Appellant's invention.

**Obviousness-U.S.C. § 103**

**Maury Does Not Disclose that which Examiner Attributes to Maury**

**Claim 10 Rejection not supported by Actual Content of the Relied upon Reference**

**Claim 11-No Prima Facie Case**

**Claim 13-No Prima Facie Case**

**Claim 19-No Prima Facie Case**

**Maury is NOT Prior**

**Precedent Governing Effective Date of a 102(e) Reference**

Note on Variations not yet Addressed by the Courts

Specific Legal Error

Examiner will address Appellant's arguments in sequence as they appear in the brief.

ARGUMENT

Appellant errs in the statement in this section of the grounds of rejection to be reviewed on appeal; Examiner notes that claims 3-15, 19-21, and 24 should have been listed as the claims to be appealed.

1. ERROR 1:           Maury does not disclose Appellant's invention and no *prima facie* case of obviousness exists.

There is no specific argument under this heading; the subject matter is discussed below.

2. ERROR 2           The Maury provisional application does not contain the limitations of Appellant's invention.

There is no specific argument under this heading; the subject matter is discussed below.

Obviousness-U.S.C. § 103

There is no specific argument under this heading, but rather a discussion of U.S.C. §103 and United States case law and interpretations of this code. The subject matter is discussed further below.

Maury Does Not Disclose that which Examiner Attributes to Maury

Although Appellant argues that the Maury reference fails to disclose Appellant's claimed invention, there is no specific argument under this heading, but rather a general statement in the first paragraph on page 9 of the Appeal Brief filed 21 September 2006, followed by a continued discussion of U.S.C. §103 and United States case law and interpretations of this code. The subject matter is discussed further below.

Claim 10 Rejection not supported by Actual Content of the Relied upon Reference

At pages 10-11 of the Appeal Brief filed 21 September 2006, Appellant argues that the claim limitations in claim 10 of the Application are not taught or suggested by the applied reference. In response, all of the limitations which Applicant disputes are missing in the applied reference have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the teachings of the cited reference, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as

detailed in the 35 USC § 103 rejections given in the prior Office Action (paper number 12092005), and incorporated herein. In particular, Examiner notes that the limitations of “transforming the actuary-manipulable representation to the executable representation,” as argued by Appellant on pages 10-11, are taught by the applied reference. In this regard, Examiner respectfully notes that Appellant’s invention is directed to “techniques, systems, encodings and functional sequences associated with the transformation of an insurance calculation base defined in a form suitable for manipulation by business users, e.g., actuaries, underwriters, product managers, etc., to an executable form suitable for use in rating, pricing or otherwise evaluating an insurance product” (Appellant’s Specification, page 3, last paragraph). Examiner further notes that in Appellant’s disclosure “uses of particular encodings, including eXtensible markup language (XML) encodings and Java™ or object-oriented programming language constructs, are merely exemplary” and that “[i]n particular, the invention is not limited to any particular encodings, programming techniques or executable forms,” (Appellant’s Specification, page 4, lines 7-10). And, for additional clarification on Appellant’s transformation to executable form, Appellant’s Specification teaches that “[c]ompiler 141 transforms a representation of calculation base 110 from user- or actuary-manipulable form to an intermediate form such as objects, methods and interfaces defined in accordance with the Java™ programming language. *See generally*, Arnold & Gosling, The Java™ Programming Language, © 1996 by Sun Microsystems, Inc.” (Appellant’s Specification, page 5, lines 13-17), and that “[c]ompiler 142 transforms intermediate source form 120 to executable form as compiled rating model 130”

(Appellant's Specification, page 5, lines 23-24) and that "[t]ypically, compiler 142 includes any commercially available Java compiler 10 (such as the jvc compiler, available from Microsoft Corporation), although other configurations are also possible" (Appellant's Specification, page 6, lines 9-11). Appellant concludes that "[i]n this way, an application such as quote generator, web server, etc. may employ a compiled rating model 130 corresponding to an actuary-manipulable calculation base without detailed knowledge of the internals thereof" (Appellant's Specification, page 6, lines 6-8).

In this regard, Examiner notes that in the applied reference, Maury, both in the Patent Application Publication and in the Provisional Application, teaches "[t]he intended audience for the system of an embodiment of the present invention is the general public [“business users, e.g. actuaries ...”]” (Maury; paragraph [0027]), (Maury Provisional, Attachment “A,” page 5 of 29, paragraphs 1-2) and “the user has, for example, three different levels of assistance for selecting coverages. One such level is a coverage wizard [i.e. “actuary-manipulable representation”], which can utilize financial data, entered by the user [e.g. an “actuary”] and held only during the session, to make coverage recommendations [i.e. having been transformed “to the executable representation”]. The user is allowed to use the coverage wizard to understand coverages without entering financial information. The user can also choose to have no assistance and enter coverages without guidance” (Maury; paragraph [0025]), (Maury Provisional, Attachment “B,” page 3 of 20, paragraphs 1-7), and “[a]t S4, the user 60 enters a request for a quote, and the

Java module 78 formats and transfers the user data to the rating engine server 48” (Maury; paragraph [0037]), (Maury Provisional page 6, lines 3-6) followed by “[a]t S7, a quote is returned to the web application server 24 for display on a Cold Fusion page. At S8, the Oracle MI database 92 is updated to record the user information and premium (Maury; paragraph [0038]), (Maury Provisional page 6, lines 7-9); Examiner interprets this transformation from user-entered or “user-manipulable” data into a quote that results from execution by a Java module and a rating engine server to be a form of “transforming the actuary-manipulable representation to the executable representation.”

Furthermore, Examiner notes that Maury additionally teaches “[t]he system for an embodiment of the present invention provides an online auto quoting facility that provides a user with a real-time auto insurance quote. The user can initiate contact with a personal lines CSR to purchase insurance based on that quote. The system connects to the rating server 48, such as a proprietary rating engine available from Agency Management System, Inc., prefills data into a host application and stores data to be retrieved via a computer telephony integration (CTI) system. The system application is written with Cold Fusion, Java, C, C++, Hypertext Markup Language (HTML), and JavaScript. An aspect of the system and method for an embodiment of the present invention is providing the online quoting facility on affinity client websites. The system enables the user to enter data into web pages constructed with Cold Fusion Markup Language (CFML), HTML, and minimal JavaScript” (Maury; paragraph [0024]), (Maury Provisional, Attachment “A,” page 3 of

29, paragraphs 1-4); Examiner interprets these teachings of transforming data from a form that can be manipulated by a “user” or “member of the general public,” who is not required to have detailed knowledge of the processes behind the transformation (i.e. “of the internals thereof” (Specification; page 6, line 8)), to an executable form, where the data can be prefilled, stored, accessed, and retrieved into the “rating engine” in order to provide an insurance quote, as teaching “transforming the actuary-manipulable representation to the executable representation,” as argued by Appellant on pages 10-11. Furthermore, Examiner notes that although Maury does not use the word “transforming” the meaning of “transforming” is “changing the form of” and Examiner notes that Maury, as discussed above, does teach changing the form of the data representation.

With regard to Appellant’s objections to Examiners statements that certain limitations are “well known in the art” and to Appellant’s request for “evidence” in paragraph 1 of page 12 of the Appeal Brief, Examiner is surprised by these objections, as Examiner notes that Appellant did not previously clearly state why the noticed facts are not considered to be common knowledge or well known in the art. Examiner was under the impression that these limitations were admitted prior art since this rejection was clearly stated in Examiner’s first rejection of the claims, and since Examiner can find no evidence in any prior remarks of Appellant that the common knowledge or well-known in the art statement has ever been traversed, despite Appellant’s reference in the Appeal Brief to the argument/request as a “renewed” request.

Nevertheless, Examiner notes that Maury clearly teaches that “[t]he rating engine server 48 provides a rating system which allows a front-end provider to utilize Applicative Real-Time Programming (ART) rating to calculate premiums” (Maury; paragraph [0032]), (Maury Provisional, Attachment “A,” page 14 of 29, paragraph 1), and “[t]he DTP can accept multiple sets of data from different data models with the same set of actions performed on each” (Maury; paragraph [0035]) (Maury Provisional, Attachment “D,” page 1 of 6, paragraph 1), and the manipulation of “multiple data sets with multiple table blocks in each. The instructions are carried out upon each data set” (Maury; paragraph [0035]), (Maury Provisional, Attachment “D,” page 1 of 6, paragraph 1). In addition, Maury teaches “the data is uploaded to relational database system software, such as a Solaris Oracle database, to be used for management information systems (MIS) reporting” (Maury; paragraph [0026]), (Maury Provisional, Attachment “B,” page 10 of 20, section VII) and “[t]he system for an embodiment of the present invention stores data in the Oracle database 40 with Oracle database attributes. Data is passed, for example, to and from the rating engine server 48. Data is also sent to the host application 56. FIG. 4 is a chart which illustrates examples of data tables for the system of an embodiment of the present invention” (Maury; Figure 4, paragraph 0033), (Maury Provisional, Attachment “B,” page 10 of 20, section VII, page 12 of 20). As per these teachings, Examiner notes that one part of the functionality of electronic databases has always been the manipulation of data tables into graphical representations of the data, and that Maury also teaches “Oracle DB Insert



will store customer information in the Oracle DB for reporting purposes” and “[c]ustomer pages should be displayed on the browser within 3 seconds (including graphics)” (emphasis added) (Maury Provisional, Attachment “B,” page 10 of 20, section VII). Examiner interprets these teachings of Maury to be a form of “factor tables having one or more axes,” the limitation noted by Examiner as being well-known in the art, and it is Examiner’s contention that one having ordinary skill in the art at the time of the invention would have found it obvious to include factor tables having one or more axes within the method disclosed by Maury, with the motivation of furnishing an on-line quote to a user for an insurance product, such as auto insurance, which enables the quote to be presented in real time, without the delay inherent, for example, with the use of email (Maury; paragraph [0005]).

As per Appellant’s argument in paragraph 2 on page 12 of the Appeal Brief that “the Office appears to rely (in part) on the background of Applicant’s specification,” Examiner respectfully disagrees, and notes that the specification was not applied as a prior art reference, but rather included in the discussion as a further explanation of the “well-known” characteristic of factor tables having one or more axes. The remainder of paragraph 2 has been discussed earlier in this Examiner’s Answer.

Claim 11-No Prima Facie Case

At page 12, paragraph 3 of the Appeal Brief filed 21 September 2006, Appellant argues that “the ‘corresponding disclosure’ identified by the office is pure fiction.” Examiner interprets this statement to mean that Appellant does not believe in the existence of the (70 page) Maury provisional application. Examiner respectfully disagrees, as evidenced by Examiner’s specific referrals to pages and paragraphs in the Maury Provisional Application listed earlier in this Examiner’s Answer.

At pages 12-13 of the Appeal Brief filed 21 September 2006, Appellant argues that the claim limitations in the claim 11 are not taught or suggested by the applied reference, and that no *prima facie* case exists. Examiner respectfully disagrees. Although the Maury reference does not use the identical terminology to Appellant’s claim language, the Maury reference teaches steps that are components of the process of programming and software execution. Accordingly, Examiner interprets Maury’s teachings of

“a web-based application, which has three major components, including a front end which is referred to as the presentation layer. The presentation layer is developed using, for example, Cold Fusion, and runs on a web application server 24. The web application server 24 communicates with the rating engine server 48 that provides comparative rates. Thus, the system makes use of the rating engine server 48 with a knowledge based system for underwriting owned by the underwriter, and from there it feeds data into the underwriter’s CTI system, as well as back into the underwriter’s host based

system for issuance. The system is available on the Internet and is accessed, for example, via an auto insurer's web site and advertising click-through from external sites"

(Maury; paragraph [0028]), (Maury Provisional, page 4 paragraph 2);

and

"[r]etrieval and/or updating of data between the web application server 24 and the Oracle database server 40 is secured with application level user ID/passwords. Data transmission between the middleware RMI server 80 and the mainframe host application 56 are secured via MQ security. All communication paths are also secured via stateful inspection of conversations by at least two firewall layers. Confidential data is transferred between the web application server 24, the rating engine server 48, and the host 56. For communication between the web application server 24 and the user 60, Secure Sockets Layer (SSL) is used" (Maury; paragraph [0034]), (Maury Provisional, Attachment "A," page 23 of 29, second and third bulleted points);

together with Maury's description of the execution of steps including "tiers" or "levels" as taught in Maury's Figure 6 as well as in Maury Provisional, Attachment "A," pages 8 and 14 of 29, Attachment "B," pages 6 and 7 of 20, as well as in Figures F and G as teaching the limitations, wherein, for a particular calculation sequence of the actuary-manipulable representation, the transforming includes: decomposing the particular calculation sequence into layers, each layer including those steps thereof that are at a same flow control level;

for each layer, traversing the steps thereof to identify those of the variables used by the layer; for each layer, traversing the calculation sequence to identify the steps of the layer targeted by other steps of the calculation sequence and emitting code allocating storage for results of the targeted steps; and for each layer, emitting code for variable test and index calculations of the layer, as recited in dependent claim 11. Thus, it is respectfully submitted that Appellant appears to view the applied reference without considering the knowledge of average skill in the art, and it is respectfully submitted that a *prima facie* case of obviousness has been clearly established by the Examiner.

#### Claim 13-No Prima Facie Case

At page 13 of the Appeal Brief filed 21 September 2006, Appellant argues that the claim limitations in the claim 13 are not taught or suggested by the applied reference, and that no *prima facie* case exists. Examiner respectfully disagrees. Although the Maury reference does not use the identical terminology to Appellant's claim language, the Maury reference teaches steps that are components of the process of programming and software execution. Accordingly, Examiner interprets Maury's teachings of

“[t]he system connects to the rating server 48, such as a proprietary rating engine available from Agency Management System, Inc., prefills data into a host application and stores data to be retrieved via a computer telephony integration (CTI) system. The system application is written with Cold Fusion, Java, C, C++, Hypertext Markup

Language (HTML), and JavaScript. An aspect of the system and method for an embodiment of the present invention is providing the online quoting facility on affinity client websites. The system enables the user to enter data into web pages constructed with Cold Fusion Markup Language (CFML), HTML, and minimal JavaScript”

Maury; paragraph [0024]); (Maury Provisional, Attachment “A,” page 33 of 29, first bulleted point);

and

“once the Cold Fusion application 76 gets all of the input information from the user 60, it passes the information as a string object through the RMI server 80 in the web application server 24. The RMI server 80 then activates a C Dynamic Link Library (DLL) through Java Native Interface (JNI). The message is then passed to the MQSeries queue. The host application 56 picks up the application message from the queue and formats the user information in a CSR screen for quick and accurate service. This web server-to-mainframe host application message exchange makes use of a three tier distributed model. This not only makes the message exchange scalable and secure, it can also be reused in other similar application message exchanges with little or no modifications. The RMI server 80 on the middle tier server 50 uses a Java security policy file to limit the RMI server’s access on the server, sometimes referred to as a “sandbox”. Besides using the three-tiered architecture for application message passing, the security feature is restricted by the Java2 platform”

Maury; paragraph [0031]); (Maury Provisional, Attachment “A,” page 6 of 29, last paragraph to page 7 of 29, first paragraph);

together with Maury's description of the execution of steps using cross-platform or platform-independent computer software such as Java and web applications and their implementations, as taught in Maury's Figure 6 as well as in Maury Provisional, Attachment "A," pages 8 and 14 of 29, Attachment "B," pages 6 and 7 of 20, as well as in Figures F and G as teaching the limitations, a two-step compilation, a first step thereof producing a platform independent source form from the actuary-manipulable representation, and a second step thereof producing the executable representation from the platform independent source form as recited in dependent claim 13. Thus, it is respectfully submitted that Appellant appears to view the applied reference without considering the knowledge of average skill in the art, and it is respectfully submitted that a *prima facie* case of obviousness has been clearly established by the Examiner.

#### Claim 19-No Prima Facie Case

At pages 13-14 of the Appeal Brief filed 21 September 2006, Appellant argues that the claim limitations in the claim 19 are not taught or suggested by the applied reference, and that no *prima facie* case exists. Examiner respectfully disagrees. Although the Maury reference does not use the identical terminology to Appellant's claim language, the Maury reference teaches steps that are components of the process of programming and software execution. Accordingly, Examiner interprets Maury's teachings of

“[r]etrieval and/or updating of data between the web application server 24 and the Oracle database server 40 is secured with application level user ID/passwords. Data transmission between the middleware RMI server 80 and the mainframe host application 56 are secured via MQ security. All communication paths are also secured via stateful inspection of conversations by at least two firewall layers”

(Maury; paragraph [0034]); (Maury Provisional, Attachment “A,” page 23 of 29, second and third bulleted points); and

“[o]nce the Cold Fusion application 76 gets all of the input information from the user 60, it passes the information as a string object through the RMI server 80 in the web application server 24. The RMI server 80 then activates a C Dynamic Link Library (DLL) through Java Native Interface (JNI)”

Maury; paragraph [0031]); (Maury Provisional, Attachment “A,” page 6 of 29, last paragraph to page 7 of 29, first paragraph);

together with Maury’s description of the execution of steps as taught in Maury’s Figure 6 and paragraphs [0037]-[0039], as well as in Maury Provisional, Attachment “A,” pages 8 and 14 of 29, Attachment “B,” pages 6 and 7 of 20, as well as in Figures F and G, to teach “a lookup facility for identification of runtime identifiers” as claimed in independent claim 19.

The remainder of Appellant’s arguments regarding independent claim 19 have been addressed earlier in this Examiner’s Answer. Thus, it is respectfully submitted that Appellant appears to view the applied reference, separately and in a vacuum, without

considering the knowledge of average skill in the art, and it is respectfully submitted that a *prima facie* case of obviousness has been clearly established by the Examiner.

Maury is NOT Prior

At pages 14-15 of the Appeal Brief filed 21 September 2006, Appellant argues that “the disclosure of the provisional application and that of the relied upon Maury publication *differ greatly* ... and [the differences] are material to Maury’s effective date as a reference...” Examiner respectfully disagrees. Consequently, Examiner has, throughout this Examiner’s Answer, provided specific referrals to Pages and Paragraphs and Figures in both the applied Maury reference and in the Maury’s 70 page Provisional Application, filed 19 May, 2000, that support the rejections of Appellant’s recited claim limitations.

Thus, it is respectfully submitted that Maury is a valid prior reference, since disclosure sufficient to reject Appellant’s claims have been found in both the Maury publication and in the disclosure content of Maury’s provisional application.

Precedent Governing Effective Date of a 102(e) Reference

This section, on pages 15-17 of the Appeal Brief filed 21 September 2006, contains a discussion of legal precedents governing the effective date of a U.S.C. §102(e) reference,



and includes United States case law and interpretations of this code. Examiner thanks Appellant for this informative discussion, however Examiner observes that the subject matter argued has been discussed earlier in this Examiner's Answer.

Note on Variations not yet Addressed by the Courts

This section, on page 17 of the Appeal Brief filed 21 September 2006, contains a discussion of the alleged lack of legal precedents governing the effective date of a U.S.C. §102(e) reference, and includes further §102(e) date analysis and additional case law interpretations of code. Examiner thanks Appellant for this informative discussion, however Examiner observes that this subject matter argued has been discussed earlier in this Examiner's Answer.

Specific Legal Error

With regard to Appellant's assertions that Examiner has failed to address the assertions, in Appellant's Amendment After-Final, that the Maury Provisional Patent Application Number 60/206,007 does not contain the information disclosed in the applied passages of Maury, U.S. Patent Application Publication Number 2002/0046064, Examiner respectfully disagrees. Examiner calls attention to the previous Advisory Action, (paper number 05082006) responding to the Amendment After-Final, in which Appellant alleged (for the first time) that "[a] brief review of Maury reveals that various aspects of the disclosure

(description and figures) relied upon in the rejection do not appear in U.S. Provisional Patent Application Serial No. 60/206,007.” In that Advisory Action, Examiner stated:

“Examiner notes that the following attachments to the Maury Provisional Application, for example, disclose the information present in the applied passages: Attachment "A," pages 8 and 14 of 29 show the flow chart disclosed in Figure 6 and discussed in the applied passages; Attachment "B," pages 6 and 7 of 20 show the system disclosed and discussed in the applied passages; Attachments "F" and "G" show the schematic flow chart and system disclosed and discussed in the applied passages. As such, the Examiner considers the Maury provisional application to support the aspects of the disclosure relied upon in the previous rejections (papers number 06212005 and 12092005)” (emphasis added) (paper number 05082006, paragraph i).

Examiner does not interpret these correspondences to be “generalities,” as asserted by Appellant, but rather explicit citations of passages in the provisional application that correspond to applied passages in Maury, as requested in Appellant’s response After-Final.

With respect to Appellant’s arguments in the remaining paragraphs in this section, these have been addressed earlier in this Examiner’s Answer.

### **Conclusion**

Appellant’s arguments at pages 7-19 of the Appeal brief submitted 21 September 2006 do not appear to persuasively require a withdrawal of the Examiner’s grounds of rejection. As specified in the remarks and rebuttals given above, Appellant’s arguments apparently fail to

appreciate the clear and unmistakable suggestions provided in the prior art of record, and relied upon by the Examiner for motivation to combine such well-known elements of the prior art. As such, it is respectfully submitted that an explanation based on logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner both in the present Examiner's Answer as well as the previous Office Action (Paper Number 12092005), *Ex parte Levensgood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

Thus, in light of the reasons and responses given above, it is respectfully submitted that a *prima facie* case of obviousness has been clearly established by the Examiner.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

**(12) Notice to Appellant – Reply is Required**

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* dismissal of the appeal as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Natalie A. Pass  
Examiner, Art Unit 3686

/N. A. P./  
December 5, 2008

A handwritten signature in black ink, appearing to read 'G. O'Connor', with a large loop at the start and a horizontal line extending to the right.

Gerald J. O'Connor  
Supervisory Patent Examiner  
Group Art Unit 3686

**A Technology Center Director or designee must personally approve the new  
ground(s) of rejection set forth in section (9) above by signing below:**

Wynn W. Coggins

Director, Technology Center 3600

Conferees:

Gerald J. O'Connor  
Supervisory Patent Examiner  
Group Art Unit 3686



for

Christopher L. Gilligan  
Supervisory Patent Examiner  
Tech Center 3626

Vincent A. Millin  
Appeals Practice Specialist  
Technology Center 3600



for

Alexander G. Kalinowski  
Supervisory Patent Examiner  
Tech Center 3691



WYNN W. COGGINS  
TECHNOLOGY CENTER DIRECTOR